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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,787	01/27/2004	Mary M. DaRif	6962D1	2596

7590 09/23/2004
The Sherwin-Williams Company
11 Midland Bldg. - Legal Dept.
101 Prospect Avenue, N.W.
Cleveland, OH 44115

EXAMINER

GREEN, BRIAN

ART UNIT PAPER NUMBER

3611

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/765,787

Applicant(s)

DARIF ET AL.

Examiner

Brian K. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-19 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-19 and 25-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

In the preliminary amendment, the applicant did not use the proper form in canceling the claims. The applicant should use the following form: Claims 1-15 (canceled)

Specification

The abstract of the disclosure is objected to because it does not contain a proper description of the claimed invention, i.e. a method of marketing paint. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohse (U.S. Patent No. 750,620) in view of Crosslen (U.S. Patent No. 4,265,038).

Dohse shows in figures 1-3 a paint color card comprising chip sections that are coated with layers of colored compositions (the paint colors white, yellow, orange, etc.) and perforations for allowing each of the colored compositions to be separated from the card, see page 1, column 1, lines 41-43. Dohse does not disclose placing the color card in a display rack. Crosslen shows in figures 1-7 the idea of placing paint color cards (5) within pockets formed on a display rack which includes walls (7,30). In view of the teachings of Crosslen it would have

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been obvious to one in the art to modify Dohse by placing the paint color card on a display rack which includes walls since this would allow the color cards to be displayed in a more convenient and organized manner. When the paint color card of Dohse is placed within one of the pockets of Crosslen some of the chip sections would be covered by the walls (7,30). In regard to claim 18, there is a space between the perforations of Dohse and the chip section could be folded along any one of the spaces as broadly defined. In regard to claim 19, Dohse discloses the use of a plurality of tear lines which allow the chip section to be removed from the rest of the card.

Claims 16-19,25, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Crosslen (U.S. Patent No. 4,265,038) and Teter et al. (U.S. Patent No. 6,112,665).

The applicant's admitted prior art in the specification page 1, lines 19-27 and page 2, lines 10-14 discloses the idea of placing paint chips within a rack and the idea of using paint chips with a plurality of color samples on a single card and the idea of covering a paint chip with a single color. The applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 does not disclose whether the display rack includes a wall which covers a chip section and the idea of placing perforations in the card to form a paint chip section.

Crosslen shows in figures 1-7 the idea of placing paint color cards (5) within pockets formed on a display rack which includes walls (7,30). In view of the teachings of Crosslen it would have been obvious to one in the art to modify the applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 by placing the paint color card on a display rack which includes walls since this would help to protect the cards from being damaged and would

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help to hold the cards in a more secure manner. When the paint color card of the applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 is placed within one of the pockets of Crosslen some of the chip sections would be covered by the walls (7,30). Teter et al. shows in figures 4 and 5 the idea of placing perforations (14) within a colored section in order to allow the perforated area to be removed. In view of the teachings of Teter et al. it would have been obvious to one in the art to modify the applicant's admitted prior art in the specification page 1, lines 19-27 and page 2, lines 10-14 by adding perforations to the color card to form a chip section since this would allow an opening to be formed within the color coated card which would allow better color matching to be performed, as taught by Teter et al., column 4, lines 55-65. In regard to claim 17, the applicant's admitted prior art in the specification page 1, lines 10-18 discloses the idea of using paint color cards having a plurality of colors on each card. The chip section formed by the perforations would be smaller in every direction than the chip sections of the paint color card. In regard to claim 18, there is a space between the perforations of Teter et al. and the chip section could be folded along any one of the spaces as broadly defined. In regard to claims 19 and 28, Teter et al. discloses the use of a plurality of tear lines which would allow the chip section to be removed from the rest of the card. In regard to claim 25, the applicant's admitted prior art in the specification page 2, lines 10-14 discloses the idea of using paint color cards having an entire surface of the card colored with a single paint color.

Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Crosslen (U.S. Patent No. 4,265,038) and Teter et al. (U.S. Patent No. 6,112,665) as applied to claim 25 above and further in view of Edwards (U.S. Patent No. 4,992,050) or Goldsholl (U.S. Patent No. 3,224,113).

The applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Crosslen and Teter et al. disclose the applicant's basic inventive concept except for placing a color coating on the back of each chip section. Edwards discloses in the abstract the idea of placing a first color of paint on a first side of a chip section and a coating of paint on the opposite side of each chip section. Edwards discloses that the paint on the second side has a different finish as compared to the first side. Goldsholl discloses in column 1, lines 59-62, the idea of placing paint on the front and back surfaces of a paint card. In view of the teachings of Edwards or Goldsholl it would have been obvious to one in the art to modify applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 by placing a coat of paint on the second surface of each chip section since this would allow more colors/finishes to be displayed by the color card. In regard to claim 26, it is considered within one skilled in art to place the same color on the back of each chip section as on the front since this would allow the color of the paint to be seen on either side of the chip section, i.e. easier and quicker to determine the paint color shown by the color card. In regard to claim 27, the colors on each side of the paint chip sections of Edwards are considered to be of the same color but would

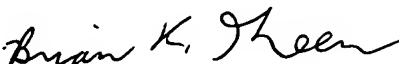
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have different compositions. Further, as indicated above, placing a coat of paint on the second surface of each chip section would allow more colors to be displayed by the card, i.e. one color on the front of the card and a second color on the back of the card. Also, when different finishes are used the colors would be slightly different.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-4177.


BRIAN K. GREEN
PRIMARY EXAMINER

Bkg
Sept. 18, 2004